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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,366	04/17/2001	Cheng-Shing Lai	LAIC3001/EM/6698	5773

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EXAMINER
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NGUYEN, LEE

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/835,366

**Applicant(s)**

LAI ET AL.

**Examiner**

LEE NGUYEN

**Art Unit**

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This action is responsive to the communication filed 04/25/2005.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said RAM" in line fourth. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Papineau et al. (US 2002/0090931) in view of Irube et al. (US 2001/0041586).

Regarding claim 1, Papineau teaches a method for selectively activating a personal digital assistant (PDA) or a mobile phone in an electronic device comprising a menu containing a PDA option and a mobile phone option

such that when said device is enabled, said PDA or said mobile phone option is selectable for generating a signal indicating said selection, and a central processing unit (CPU) for showing a prompt of said selected PDA option or said mobile phone option for use after receiving said signal, see [0022] – [0024]. Papineau inherently teaches that after the electronic device is powered on, displaying a menu containing a PDA option and a mobile phone option, see [0023] – [0024]; enabling a user to select one of said options by clicking through an activated input means [0024]; and inherently causing the CPU 106 CPU 106 (fig. 2) to determine which of said PDA option and said mobile phone option is selected (see [0023]-[0024]) and if said mobile phone option is selected and activating said mobile phone option only if said mobile phone option is selected by said user (in [0024], the user navigates through a menu to a prompt for the communications disabled operating mode and select that prompt. In this operation, it is not believed that by default after the power is on the mobile phone is selected because Papineau does not disclose that the communication mode is selected by default after the electronic device is powered on). In the alternative, Irube teaches a communication apparatus in which after the power on is set in a standby state a main menu is

displayed so that the user can select one of the telephone, videophone and data communication modes (see [0075]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the menu with selection modes of Irube to the electronic device of Papineau so that the user can select his/her desire mode of operation.

6. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papineau in view of Irube as applied to claim 1 above, and further in view of Kraft (US 6,309,305) and Nguyen (US 5,797,089).

Regarding claims 4-5, the Papineau as modified also teaches activating the mobile phone option comprising causing said CPU inherently reading a program stored in a mobile phone read only memory 218 for showing a prompt of said mobile phone, closing a switch means 232 (fig. 2) for commanding a transceiver means 202 through a control circuit 218, transmitting messages from an antenna or received by said antenna 201. Papineau does not explicitly teach operating said device for reading data from a random access memory (RAM) or writing data into said RAM. In an analogous art, Kraft teaches that RAM can be used for read/write text

message (col. 2, lines 54-67 and col. 4, lines 4-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the RAM of Kraft to the apparatus of Papineau so that programs as well as data for applications can be accessed (col. 4, lines 6-15).

Papineau as modified inherently teaches that said CPU 106 (fig. 2) reading a program stored in a PDA ROM (116) if said PDA option is selected for showing a prompt of said PDA, controlling said selected PDA option by said control circuit (see [0020]). Papineau as modified fails to teach operating said device for reading data from said RAM or writing data into said RAM. In other words, Papineau as modified fails to teach that the same RAM is used for both the mobile phone and the PDA. In an analogous art, Nguyen teaches that the same RAM can be commonly accessed by both the PDA and the mobile telephone (col. 4, lines 35-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nguyen to the apparatus of Papineau in order to save space and cost of an extra RAM.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 4-5 have been considered but are moot in view of the new ground(s) of rejection.

In the remarks, Applicant repeats the argument that Papineau teaches by default, after the apparatus is powered on, the mobile is automatically selected.


In response, first, it is not believed that Papineau discloses that the communication mode is selected by default after the electronic device is powered on (see [0023]-[0024]). Second, this argument is moot in view of new ground of rejection as stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (571)-272-7854. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NICK CORSARO can be reached on (571)-272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 7/19/05  
LEE NGUYEN  
Primary Examiner  
Art Unit 2682